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Docket No. 491332000300
1620

CERTIFICATE OF HAND DELIVERY

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Gwendolyn Peacher
Gwendolyn Peacher

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Clóvis Ryuichi NAKAIE et al.

Serial No.: 10/018,842✓

Filing Date: December 21, 2001

For: SYNTHESIS OF A NOVEL
PARAMAGNETIC AMINO ACID
DERIVATIVE (EPM-5) FOR LABELING
DIFFERENT MACROMOLECULES AND
SYSTEMS (as amended)

Examiner: Kamal A. Saeed

Group Art Unit: 1626 ✓

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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed May 30, 2003, applicants elect to prosecute the claims of Group III, claims 6, 8 and 11, *with traverse*.

The Examiner found restriction to be proper on the ground essentially that the claims do not share the same essential structural elements that define a “special technical feature” necessary to specify a contribution over the prior art. Action, pg. 3. The Examiner did not cite any prior art with the Action. Applicants will focus in this response on the Examiner’s reasoning bridging pages 3 and 4 of the Action:

The structural moiety common to Groups I-IV, pyrrolidine, ... is known in the art and, therefore, cannot said to be the special [technical feature] which makes a contribution over the prior art. All other substituents and methods of use

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differ from one another. Thus, these claims lack the corresponding special technical feature(s) necessary to link them together to fulfill the unity of invention requirement.

The inventions of Group I-IV are distinct, each from the other, because they differ in structure and/or element [sic] so as to be patentably distinct and a prior art reference anticipating but one of the groups would not render obvious the other groups under 35 U.S.C. 103. Groups I-IV are unrelated because divergent class or subclasses of compounds exist and each group is capable of supporting its own patent.

The first paragraph quoted above shows that the Examiner has clearly erred by identifying an alleged special technical feature which can easily be knocked down, like a straw man, in support of the restriction requirement. Applicants note that, by itself, pyrrolidine is well-known in the art. However, finding that “pyrrolidine” is the alleged special technical feature of the invention dissects the invention beyond all recognition and is not consistent with any known system of chemical nomenclature or any technical understanding of the subject matter of this application. The specification of this application makes it abundantly clear that the “special technical feature” of this invention is Fmoc-poac, as explained below. It is almost always possible, applicants respectfully observe, to deconstruct an invention so far that it contains no patentable special technical feature even though it may be a significant advance over the prior art. The Examiner’s deconstruction of the invention is tantamount to holding that claims to a series of aqueous solutions of closely related compounds do not share a special technical feature that is patentable over the prior art because they all contain water, which is well-known in the art. The impropriety of that logic is obvious, as should be the impropriety of the logic in the pending Action.

Unity of invention in national stage applications stemming from international applications filed under the PCT is governed by MPEP 1800 and PCT Rule 13. MPEP 1893.03(d) explains, “The basic principle [of unity of invention practice] is that an application should relate to only one invention or, if there is more than one invention, that applicant would have a right to include in a single application only those inventions which are so linked as to form a single general inventive concept.” Under this basic principle, it is apparent that *all* of the

claims in this application share a single general inventive concept, namely, the molecule set forth in claim 4, which includes a pyrrolidine nucleus but also exhibits protective groups and other groups which are necessary to its specific function as a novel spin label for peptide segments. This molecule, which this application denominates Fmoc-poac, is not disclosed in the prior art. All of the claims in this application share the use of Fmoc-poac, which is the “special technical feature” of this invention, as to which the Examiner has cited no prior art to support a finding that such a special technical feature is unpatentable. Since all of the claims in this application share the same special technical feature, the claims in this application are so linked as to form a single general inventive concept and should all be examined together. The Examiner’s search can focus on Fmoc-poac and come up with prior art applicable to all aspects of the invention as claimed.

The second paragraph on page 4 of the Action quoted above is inappropriate as support for a restriction requirement in a national stage application. There is nothing in the applicable rules or MPEP provisions to support this paragraph, which is drawn from conventional restriction practice under 37 CFR 1.141 and is not appropriate for citation in this type of application. In fact, the general principles of unity of invention practice cited above would be meaningless if this portion of the Examiner’s logic were controlling, since unity of invention practice expressly recognizes that more than one invention can be claimed in a single application if those inventions are linked so as to form a single general inventive concept. Thus, the Examiner’s factually and legally unsupported assertions of different classification and patentable distinctness do not support this restriction requirement. Applicants hasten to point out that since the Examiner’s reference to patentable distinctness is improper, it is not necessary for applicants to comment one way or the other on the propriety of the Examiner’s holding, simply to point out that is inappropriate in the analysis of unity of invention under MPEP 1893.03(d) and PCT Rule 13, which is mirrored in the MPEP provision.

In accordance with the foregoing, early action withdrawing the restriction requirement and examining claims 4-6 and 8-11 in this application is solicited. If the Examiner has any

questions regarding this response, the courtesy of a telephone call to the undersigned would be appreciated.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952, Ref. 491332000300.

Respectfully submitted,



By:

Barry E. Bretschneider
Registration No. 28,055

Morrison & Foerster LLP
1650 Tysons Boulevard
Suite 300
McLean, Virginia 22102
Telephone: (703) 760-7743
Facsimile: (703) 760-7777

Dated: June 30, 2003